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EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

FN

# Office Action Summary

Application No.

09/233,475

Applicant(s)

WAKABAYASHI, KUNIIHIKO

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al (US-PAT-NO: 6,052,442).

For claims 1, 2, 11 and 12, regarding a memory to store received digitized voice in a voice mail sent from a sender, Cooper et al teach on column 4 line 39 “incoming voice messages are digitized by A/D converter and stored in memory”.

Regarding an identifier to identify a sender number attached to the voice mail that contains the digitized voice, the sender number corresponding to the sender that has sent the digitized voice, Cooper et al teach on column 2 line 59 “when the answering machine answers a

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call, before playing an outgoing message, it may read the telephone number of the calling party using the Calling Number Delivery (CND) service". It is inherent that there must be an identifier of Cooper's system to identify the sender number.

Regarding a table that provides a correspondence between a plurality of e-mail addresses and a plurality of sender numbers, respectively, wherein the digitized voice is stored at a particular memory address that is assigned to the sender within the memory, based on the identification of the sender number as performed by the identifier, and wherein the table is accessed to allow a recipient of the digitized voice to send an e-mail response to the corresponding e-mail address of the sender, Cooper et al teach on column 9 line 40 "memory may include a pre-stored correspondence or 'telephone directory' between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders into the telephone directory". The "telephone directory" of Cooper et al is the claimed "table". The "between telephone numbers and.....other identifying information.....the user may also choose to automatically store email addresses of some or all senders" reads on the claimed "correspondence between a plurality of e-mail addresses and a plurality of sender numbers". Cooper et al also teach on column 9 line 34 "processor stores the (telephone) number in memory along with the message at the time it is received". The "stores the (telephone) number in memory along with the message" of Cooper et al reads on the claimed "voice is stored at a particular memory address that is assigned to the sender within the memory based on the identification of the sender number". Cooper et al also teach on column 11 line 26 "the user may select the destination address by using keypad to choose an entry in the telephone directory stored in memory". The "using keypad to choose an entry in the telephone directory" of

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Cooper et al is the claimed "the table is accessed to allow a recipient....". Cooper et al also teach on column 7 line 44 "the user may compose text for the reply using keypad". The "text for the reply" of Cooper et al reads on the claimed "send an e-mail response".

Regarding claims 3 and 4, Cooper et al teach on column 4 line 38 "incoming email messages are stored directly in memory". The "email messages" of Cooper et al is the claimed "digitized document".

Regarding claims 5 and 6, Cooper et al teach on column 3 line 34 "The user may also compose either an email message or a voice message to send the message via the Internet to a remote email address. This composed message may be a reply to a previously received message". The "email message" of Cooper et al is the claimed "digitized reply document". It is inherent that the voice message must be digitized for sending via the Internet. It is also inherent that there must be a transmitter to send to transmit the reply.

Regarding claims 7, 8, 9, 10, 15 and 16, Cooper et al teach on column 3 line 34 "The user may also compose either an email message or a voice message to send the message via the Internet to a remote email address. This composed message may be a reply to a previously received message". Cooper et al teach on column 4 line 33 "an analog-to-digital (A/D) converter". The "an analog-to-digital (A/D) converter" of Cooper et al is the claimed "documentation converter". The analog reply voice message is converted by the A/D converter

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to a digitized reply document for sending via Internet. It is inherent that the system of Cooper must have a transmitter to transmit the digitized reply document.

Regarding claims 13 and 14, Cooper et al teach on column 11 line 26 "The user may select the destination address by using keypad to choose an entry in the telephone directory stored in memory". The "select the destination address by using keypad to choose an entry in the telephone directory" of Cooper et al reads on the claimed "address that has been found after performing retrieval of the table". Regarding transmitting digitized reply document and digitized reply voice", the rejections stated in claims 7 and 8 above apply.

### ***Response to Arguments***

2. Applicant's arguments filed on 11/25/02 have been fully considered but they are not persuasive.
  - i) Applicant argues, on page 4 of REMARKS, it is requested that the Examiner acknowledge Applicant's claim for foreign priority. The acknowledgement has been indicated on the Office Action Summary.
  - ii) Applicant argues, on pages 4-5, the referenced prior art (Hyde-Thompson) does not teach the present invention. However, a new prior art (Cooper et al ) is referenced to reject claims 1-16 in this office action.

***Conclusion***

3. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Picard et al (US-PAT-NO: 6,233,318) teach system for accessing multimedia mailboxes and messages over the internet and via telephone.

4. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

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Patent Examiner

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Ming Chow

(m)

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', with a long horizontal stroke extending to the right.